

## REMARKS

The present application was filed on June 29, 2001 with claims 1 through 45. Claims 1 through 45 are presently pending in the above-identified patent application. Claims 1, 3, 20, 25, 33, 34, 36, 38-42, 44, and 45 are proposed to be amended herein.

5 In the Office Action, the Examiner rejected claim 33 under 35 U.S.C. §112, sixth paragraph, and objected to FIG. 1, claim 25, and the disclosure due to indicated informalities. The Examiner rejected claims 3, 15, and 33-45 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and rejected 10 claims 1-45 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner rejected claims 1-5, 10, 14, 15, 18-22, 26, 30-35, 39, and 43-45 under 35 U.S.C. §103(a) as being unpatentable over Miller et al. (United States Patent Publication Number 2002/0026369) in view of Goldberg et al. (United States Patent Number 6,985,885), and rejected claims 6-9, 11-13, 16, 17, 23-25, 27-29, 15 36-38, and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al., and further in view of Haddawy (“An Overview of Some Recent Developments in Bayesian Problem-Solving Techniques,” AI Magazine, La Canada, Summer 1999, Vol. 20, Issue 2, page 11, 9 pages).

### Formal Objections

20 Claim 33 was rejected under 35 U.S.C. §112, sixth paragraph, and FIG. 1, claim 25, and the disclosure were objected to due to indicated informalities. In particular, the Examiner asserts that claim 33 contains computer-readable code means, but that the structure of the claim is not that of a means plus function claim. Regarding FIG. 1, the Examiner asserts that block 104 is labeled “Electronic Marketplace” and that the 25 specification on page 11, line 10, refers to it as “market makers”. Regarding the specification, the Examiner notes that there are several typographical errors.

Regarding claim 33, please note that the cited claim and dependent claims 34, 36, 38-42, 44, and 45 have been amended to address the Examiner’s concern.

30 Please note that FIG. 1 has been amended to label block 104 as “market makers,” and that claim 25, the abstract, and the specification have been amended to correct the typographical errors noted by the Examiner.

Section 101 Rejections

Claims 1-45 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner asserts that the cited claims do not provide a practical application of an idea resulting in a useful, 5 concrete and tangible result

The Supreme Court has stated that the "[t]ransformation and reduction of an article 'to a different state or thing' is the clue to patentability of a process claim." *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 U.S.P.Q. (BNA) 676 (1972). In other words, 10 claims that require some kind of transformation of subject matter, which has been held to include intangible subject matter, such as data or signals, that are representative of or constitute physical activity or objects have been held to comply with Section 101. *See, for example, In re Warmerdam*, 31 U.S.P.Q. 2d (BNA) 1754, 1759 n.5 (Fed. Cir. 1994) or *In re Schrader*, 22 F.3d 290, 295, 30 U.S.P.Q. 2d (BNA) 1455, 1459 n.12 (Fed. Cir. 1994).

15 Thus, as expressly set forth in each of the independent claims, the claimed methods or system enables an electronic information marketplace by transforming the collected request from a buyer for a requested information good and the one or more offered information goods from one or more sellers to a match between the request and the at least one of the offered information goods. This transformation to a match 20 provides a useful, concrete and tangible result.

Applicants submit that each of the claims 1-45 are in full compliance with 35 U.S.C. §101, and accordingly, respectfully request that the rejection under 35 U.S.C. §101 be withdrawn.

Section 112 Rejections

25 Claims 3, 15, and 33-45 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the Examiner asserts that the limitation "comparing the additional information from the request and the request with the additional information" 30 is not clear.

Applicants note that claim 3 requires comparing the additional information from the request and the request with the additional information from the at least one information good and the at least one offered information good. Thus, the cited limitation is a comparison step comparing a number of entities: the additional information from the request; and the request with the additional information from the at least one information good and the at least one offered information good. Since claim 1 requires “analyzing the request to create additional information from the request,” the former entity (the additional information from the request) is created from an analysis of the request. In addition, since claim 1 requires “analyzing each of the offered information goods to create additional information from the information good,” the latter entities (the request with the additional information from the at least one information good and the at least one offered information good) are created from an analysis of each of the offered information goods. In any case, claim 3 has been amended to require wherein the step of matching further comprises the step of matching the request with at least one of the offered information goods by comparing the additional information from the request and *the additional information from the at least one information good* and the at least one offered information good.

Regarding claims 15, 31, and 44, the Examiner asserts that it is not clear what is being exchanged and asks “is the seller receiving funds after completion of the exchange?”

The cited claims require the step of exchanging the at least one offered information good and the requested information good, whereby the buyer has the at least one offered information good and one of the sellers has the requested information good after the exchange. Applicants note that an exchange is defined as “to part with in return for some equivalent” (See, dictionary.com.) Thus, the exchange of the at least one offered information good and the requested information good would be clear to a person of ordinary skill in the art. Applicants also note that the claims *do not require receiving funds*.

Regarding claim 33, the Examiner asserts that a computer readable code means cannot comprise steps.

Claim 33 has been amended to address the Examiner’s concern

Independent Claims 1, 20 and 33

Independent claims 1, 20, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al. Regarding claim 1, the Examiner asserts that Miller discloses collecting a request from a buyer for a requested good (paragraph [0007])

In the text cited by the Examiner, Miller teaches that “a system, method and article of manufacture are provided for matching products to a *textual request*.” (See, paragraph [0007]; emphasis added.) Applicants, however, could find no disclosure or suggestion of collecting a request from a buyer for a requested information good, *wherein the request comprises non-textual information*. Independent claims 1, 20, and 33, as amended, require collecting a request from a buyer for a requested information good, *wherein said request comprises non-textual information*. Support for this amendment can be found on pages 22-24 of the originally filed specification. In particular, the present specification teaches that the request can comprise spectral bands (page 22, lines 18-24), spatial texture and/or weather pattern(s) (page 23, lines 4-12), and ground moisture (page 23, line 27, to page 24, line 5)

Thus, Miller and Goldberg et al., alone or in combination, do not disclose or suggest collecting a request from a buyer for a requested information good, wherein said request comprises non-textual information, as required by independent claims 1, 20, and 33, as amended

Additional Cited References

Haddaway was also cited by the Examiner for its disclosure, for example, that “any Bayesian network inference algorithm can be used.” Applicants note, however, that Haddaway does not address the issue of collecting a request from a buyer for a requested information good, *wherein the request comprises non-textual information*

Thus, Haddaway does not disclose or suggest collecting a request from a buyer for a requested information good, wherein said request comprises non-textual information, as required by independent claims 1, 20, and 33, as amended.

Dependent Claims 2-19, 21-32 and 34-45

Dependent claims 2-5, 10, 14, 15, 18, 19, 21, 22, 26, 30-32, 34, 35, 39, and 43-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al

in view of Goldberg et al , and claims 6-9, 11-13, 16, 17, 23-25, 27-29, 36-38, and 40-42 were rejected under 35 U S.C §103(a) as being unpatentable over Miller et al. in view of Goldberg et al. , and further in view of Haddaway.

5 Claims 2-19, 21-32 and 34-45 are dependent on claims 1, 20, and 33, respectively, and are therefore patentably distinguished over Miller et al. , Goldberg et al. , and Haddaway (alone or in any combination) because of their dependency from amended independent claims 1, 20, and 33 for the reasons set forth above, as well as other elements these claims add in combination to their base claim

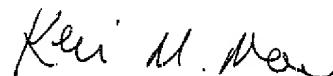
10 All of the pending claims, i e , claims 1-45, are in condition for allowance and such favorable action is earnestly solicited

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated

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Respectfully submitted,



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Kevin M. Mason  
Attorney for Applicants  
Reg. No. 36,597  
Ryan, Mason & Lewis, LLP  
1300 Post Road, Suite 205  
Fairfield, CT 06824  
(203) 255-6560

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Annotated Sheet Showing Changes

FIG. 1

